

REMARKS

Applicant has now had an opportunity to carefully consider the Examiner's action, and respectfully submits that the subject application is now in condition for allowance based upon the amendments presented herein and the following remarks.

Pending Claims

The subject application was originally filed with 26 claims. During a telephone conversation with Timothy Krogh on January 18, 2006, a provisional election was made with traverse to prosecute the tire/tire kit claims (i.e., claims 1-7, 12-17, and 23-26). This election is hereby affirmed by Applicant. In the present Amendment, Applicant has cancelled claims 2, 12, 16, 17, 23 and 25-26 without prejudice to presentation of these claims, or the subject matter contained therein, in this or a later filed case. Accordingly, upon entry of this Amendment, claims 1, 3-7, 13-15 and 24 will be pending in the subject application.

Summary of Office Action

In the Office Action dated January 23, 2006, the Examiner:

- (1) rejected claims 1-3 and 5 under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 4,714,099 issued to McGlashen ("the '099 patent");
- (2) rejected claims 12-17 and 23-26 under 35 U.S.C. § 102(a) as being anticipated by Great Britain publication number 2,381,367 ("the '367 Great Britain publication"); and
- (3) rejected claims 4, 6, and 7 under 35 U.S.C. § 103(a) as being unpatentable over the '099 patent and further in view of U.S. Patent No. 2,985,216 issued to Williams ("the '216 patent").

Rejections to Claims 1-3 and 5 under 35 U.S.C. § 102(b)

As a preliminary matter, claim 2 has been cancelled without prejudice rendering the rejection of this claim moot.

Under 35 U.S.C. § 102, a claim is anticipated only if each and every limitation as set forth in the claim is found, either expressly or inherently described, in a single prior art

reference. Applicant asserts that the '099 patent fails to expressly or inherently disclose each and every limitation recited in amended claim 1 for several reasons.

First, the '099 patent fails to disclose or suggest a high visibility marking on the sidewall of a tire that provides the tire changer with a quickly identifiable and recognizable indicator of which side of the racing vehicle the tire must be mounted. Such quickly identifiable and recognizable indicator is imperative during a race where time is of the essence. In contrast, the '099 patent discloses the use of a small arrow to indicate the direction of the cords of the bead reinforcing plies (column 2, lines 49-52). This ply direction marking is neither highly visible, nor used to (or able to) provide a quick and recognizable indicator to a tire changer.

Second, the '099 patent fails to disclose a tire having indicia that requires such tire to be mounted solely on the left side or solely on the right side of the racing vehicle as recited in amended claim 1. In contrast, the directional marking of the '099 patent simply provides the direction of the cords of the bead reinforcing plies. The tire changer must still choose on which side of the vehicle to mount the tires. For example, tires having markings pointing in the same direction could be mounted on opposite sides of the vehicle (column 1, lines 43-44). In the alternative, tires having markings pointing in opposite directions could be mounted on opposite sides of the vehicle (column 3, lines 22+). In summary, the tires of the '099 patent are capable of being mounted on both sides of the vehicle, while the claimed tire kit requires the tires contained therein to be configured for solely left side or solely right side installation.

Regarding dependent claims 3 and 5, the '099 patent fails to disclose the features recited in these claims as well. For example, Figure 1 of the '099 patent discloses a small arrow pointing in the direction of the cords of the bead reinforcing plies. In this figure, the marking itself points in the direction of the cords of the bead reinforcing plies. Nowhere in the '099 patent does it disclose or suggest the use of a letter, numeral, trademark, company logo, ornamental design, decorative pattern or combinations thereof to indicate the direction of the cords of the bead reinforcing plies, let alone be used to indicate the side of the vehicle on which to install the tire. In addition, from the teaching of the '099 patent, one skilled in the art would not contemplate use of a letter, numeral, trademark, company logo, ornamental design, decorative pattern or combinations thereof to indicate the installation side of a particular tire.

For the reasons discussed above, the '099 patent fails to expressly or inherently disclose each and every limitation of claims 1, 3, and 5. Accordingly, Applicant respectfully requests that the rejections to these claims be withdrawn.

Rejections to Claims 12-17 and 23-26 under 35 U.S.C. § 102(a)

As a preliminary matter, claims 12, 16, 17, 23 and 25-26 have been cancelled without prejudice rendering the rejection with respect to these claims moot.

Applicant asserts that the '367 Great Britain publication fails to disclose each and every claim limitation, either expressly or inherently, recited in claims 13-15 and 24. Specifically, the '367 Great Britain publication fails to disclose color markings that indicate to the racing audience the rubber composition of the tire, the points leader of a vehicle racing series, or the pole position holder of a racing event. In contrast, the '367 Great Britain publication discloses markings on the sidewall of a tire that become "legible" as the tire is rotating. As shown in Figures 1a and 1b, the invention is directed to arranging meaningless markings on the sidewall of the tire, such that they create "legible" information, such as advertising or the speed of the vehicle, when the tire is rotating. Nowhere in the '367 Great Britain publication does it disclose or suggest the use of color markings to indicate the tire rubber composition, points leader, or pole position holder.

Regarding claim 24, the '367 Great Britain publication does not expressly or inherently disclose use of a high visibility color marking to designate the specific installation side of the tire. There is no teaching in the '367 Great Britain publication directed to using a color marking on a tire to indicate the specific side of the vehicle the tire is to be mounted.

Based on the foregoing, the '367 Great Britain publication fails to expressly or inherently disclose each of the limitations recited in claims 13-15 and 24. Accordingly, Applicant respectfully requests that the rejections to these claims be withdrawn.

Rejection to Claims 4, 6, and 7 under 35 U.S.C. § 103(a)

To establish a *prima facie* case of obviousness under 35 U.S.C. §103, three basic criteria must be met. First, the prior art reference (or references when combined) must teach or suggest each and every claim limitation. Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the

art, to modify the reference or to combine reference teachings. Finally, there must be a reasonable expectation of success to modify the reference or to combine reference teachings.

Applicant asserts that the combination of the '099 patent and the '216 patent fail to teach or suggest each and every claim limitation of dependent claims 4, 6 and 7 for the reasons discussed above with respect to amended claim 1, since claims 4, 6 and 7 depend either directly or indirectly from claim 1. Accordingly, Applicant respectfully submits that a *prima facie* case of obviousness has not been established. Therefore, Applicant respectfully requests that the Examiner withdraw the rejection to claims 4, 6 and 7 under 35 U.S.C. § 103(a).

Conclusion

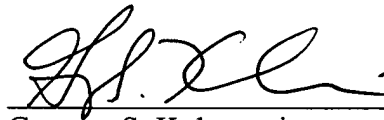
In view of the remarks above and the amendments presented herein, it is believed that claims 1, 3-7, 13-15 and 24 are in condition for allowance and notice to such effect is respectfully requested. If the Examiner thinks a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned at the phone number provided below.

The Commissioner is hereby authorized to charge any necessary additional fees, or credit any overpayment, to Deposit Account No. 02-2051, referencing Docket No. P04024US1A.

Respectfully submitted,

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